



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/629,226

07/28/2003

Brad Haeblerle

2003P11236US

5321

7590

02/13/2006

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

GORTAYO, DANGELINO N

ART UNIT

PAPER NUMBER

2168

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/629,226	Applicant(s) HAEBERLE ET AL.	
	Examiner Dangelino N. Gortayo	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-11 are pending.
2. Preliminary amendments to the specification, the drawings, and the claims filed on 7/12/2004 have been entered for examination.

Drawings

3. The drawings were received on 1/20/2004. These drawings are acceptable.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Abstract recites "a method and system is disclosed" in line 1 and should be avoided. Proper correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

Art Unit: 2168

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10628978. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application describes method steps that differ from copending application 10/628978 only in the type of data being processed.

As per claim 1, copending application 10/628978 discloses "A computer implemented method for displaying information relating to service contracts for a plurality of building sites:" (claim 1 lines 1-2) "providing a web portal comprising a database, and storing information about a plurality of service contracts for a plurality of building sites in said database;" (claim 1 lines 3-4) "receiving a request from one or more clients to display said information for a plurality of building sites the user is authorized to view;" (claim 1 lines 5-6) "determining a plurality of service activities that

are implicated by said request;" (claim 1 line7) "and transmitting said information such that said information is capable of being displayed on a client display." (claim 1 line 8)

As per claims 2-11, copending application 10/628978 claims 2-8 are not patentably distinct from claims 2-11 of the instant application, and can be mapped in a similar manner to warrant a double patenting rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

7. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-24 of copending Application No. 10628977. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application describes method steps that differ from copending application 10/628978 only in the type of data being processed.

As per claim 1, copending application 10/628977 discloses "A computer implemented method for displaying information relating to service contracts for a plurality of building sites:" (claim 13 lines 1-2) "providing a web portal comprising a database, and storing information about a plurality of service contracts for a plurality of building sites in said database;" (claim 13 lines 3-5) "receiving a request from one or

more clients to display said information for a plurality of building sites the user is authorized to view;" (claim 13 lines 6-7) "determining a plurality of service activities that are implicated by said request;" (claim 13 lines 8-9) "and transmitting said information such that said information is capable of being displayed on a client display." (claim 13 line 10-11)

As per claims 2-11, copending application 10/628977 claims 14-24 are not patentably distinct from claims 2-11 of the instant application, and can be mapped in a similar manner to warrant a double patenting rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-2 and 5-11 all use the phrase "capable of

Art Unit: 2168

being displayed". It is unclear what the applicant's intended metes and bounds of the claim are, since the claims appear to cover anything and everything that does not prohibit actions from occurring. Proper correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kalantar et al. ("Kalantar" Us # 6,954,737 B2).

As per claim 1, Kalantar teaches "A computer implemented method for displaying information relating to service contracts for a plurality of building sites:" (see Abstract)

"providing a web portal comprising a database, and storing information about a plurality of service contracts for a plurality of building sites in said database;" (Figure 1 reference 140 and column 6 lines 48-55, wherein a central management server is coupled with a database and performs similar functions).

"receiving a request from one or more clients to display said information for a plurality of building sites the user is authorized to view;" (column 22 lines 40-67, wherein an EMI unit sends a request, which includes user authorization, for the central management server to process, to view service information)

"determining a plurality of service activities that are implicated by said request;" (column 12 lines 39-48, wherein the request is processed to determine which services are called)

"and transmitting said information such that said information is capable of being displayed on a client display." (Figures 12-21 and column 24 lines 48-65, wherein the information is transmitted to an EMI client to be displayed on screen).

As per claim 2, Kalantar teaches "receiving a user request to display information about service contracts for an individual building site," (column 32 lines 11-24, wherein a user request is received by the central management system for a work schedule, which shows services to be performed at specific times) "and transmitting said information such that said information is capable of being displayed on a client display. (column 24 lines 48-65, wherein the information is transmitted to an EMI client to be displayed on screen).

As per claim 3, Kalantar teaches "said information further comprises information about the type of building system a service contract pertains to." (column 10 lines 43-51, wherein the information to be transmitted includes a facility id, which identifies the building system for the tasks to be performed).

As per claim 4, Kalantar teaches "said information further comprises information about the type of equipment covered under the service contract." (column 11 lines 34-44, wherein facility records in the database identifies tasks to be performed, identifying equipment for which tasks should be performed).

As per claim 5, Kalantar teaches "receiving a request from a client for information about the service history for a service contract," (column 32 lines 58-64, wherein the central management server receives a request from an EMI client that includes work status update reports, including service history) "and transmitting said information such that said information is capable of being displayed on a client display." (column 33 lines 7-17, wherein the central management server sends back the requested information to be displayed on a screen on the EMI client).

As per claim 6, Kalantar teaches "receiving a request from a client to display further information about an individual service activity," (column 33 lines 25-40, wherein a central management server receives a request including a task identifier for individual tasks to be completed) "and transmitting said information such that said information is capable of being displayed on a client display." (column 33 lines 7-17, wherein the central management server sends back the requested information to be displayed on a screen on the EMI client).

As per claim 7, Kalantar teaches "transmitting said information such that said information is capable of being displayed according to the type of system said contracts pertain to." (column 13 lines 57-65, wherein the central management server can send to an EMI client task icons related to the type of facility it is being sent to).

As per claim 8, Kalantar teaches "transmitting said information such that said information is capable of being displayed according to the type of equipment said service contracts pertain to." (column 14 lines 5-23, wherein the information sent is pre-determined by the request and the type of service called for, including the equipment needed to complete the task).

As per claim 9, Kalantar teaches "transmitting said information such that said information is capable of being displayed according to the status of the said service contracts." (column 32 lines 25-43, wherein the central management server sends task status information and is analogous).

As per claim 10, Kalantar teaches "transmitting information about one or more building sites covered under a service contract such that said information is capable of being displayed on a client display." (column 16 line 56 – column 17 line 4, wherein information includes data stored in the EMI locally, specific to the facility it is in).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kalantar et al. ("Kalantar" Us # 6,954,737 B2) in view of Duenke ("Duenke" US Pub No. 2002/00264343 A1)

As per claim 11, Kalantar teaches "receiving a request" (column 22 lines 40-67, wherein the central management server receives a request from an EMI client).

Kalantar does not expressly teach "to display a technical diagram about a piece of equipment covered under a service agreement and transmitting said technical diagram such that it is capable of being displayed on a client display."

Duenke teaches "to display a technical diagram about a piece of equipment covered under a service agreement and transmitting said technical diagram such that it is capable of being displayed on a client display." (Figure 12 and block [0063], wherein a technical diagram about equipment is shown on a display from a client computer pulled from a central database server).

It would have been obvious at the time of the invention for one of ordinary skill in the art to combine Kalantar's method of displaying service information from a work management network with Duenke's method of displaying a technical diagram about a piece of equipment. This gives the user of a work management network the added capability of viewing technical diagrams to identify problems. The motivation for doing so would be to provide an individual with graphical illustration when using a work-related system.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Masui et al. (US # 6,917,859 B2)

Hull et al. (US # 6,598,056 B1)

Hull et al. (US # 6,487,457 B1)

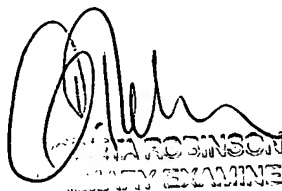
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dangelino N. Gortayo whose telephone number is (571)272-7204. The examiner can normally be reached on M-F 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dangelino N. Gortayo
Examiner

DG


DANGELINO N. GORTAYO
EXAMINER 2/3/02